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Paper No. 16
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Steve Lance
v.
Richard Brown

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Opposition No. 112,687
to application Serial No. 75/331,924
filed on July 28, 1997

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Edward H. Rosenthal of Frankfurt, Garbus, Klein & Selz, PC for Steve Lance.

Robert I. Pearlman for Richard Brown.

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Before Simms, Cissel and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 28, 1997, Richard Brown filed the above-referenced application to register the mark "TALKING PICTURES" on the Principal Register for what were subsequently identified by amendment as "entertainment and educational services, namely, seminars, interviews and screenings related to the film industry," in Class 41. The application was based on Mr. Brown's assertion that he

possessed a bona fide intention to use the mark in commerce in connection with the services.

Following publication of the mark, a timely Notice of Opposition was filed by Steve Lance. As grounds for Opposition, he asserted that he has used the mark the applicant seeks to register in connection with a weekly radio call-in show devoted to the movies and cinema since prior to the filing date of the opposed application, and that applicant's use of the same mark in connection with the closely related or identical services set forth in the application would be likely to cause confusion. Applicant denied the essential allegations put forth in the Notice of Opposition.

A trial was conducted in accordance with the Trademark Rules of Practice, but applicant neither took nor provided discovery, and although opposer took the testimony of Steve Lance, applicant did not attend that deposition and took no testimony in defense of his position that confusion is not likely. Opposer file a brief, but applicant did not. No oral hearing before the Board was requested.

The issues in this proceeding are priority in likelihood of confusion. Based on careful consideration of the record and arguments before us, we find that opposer has established priority of use of "TALKING PICTURES" in connection with his services, and if applicant were to use

the same mark in connection with the services set forth in the application, confusion would be likely.

In view of the fact that this record contains no proof that applicant has ever used the mark it seeks to register and the fact that the application based on applicant's intention to use the mark was filed on July 28, 1997, in order to establish priority, under Section 7(c) of the Act, opposer needed to prove that he had used the mark before that date. Miller Brewing Co. v. Anheuser-Bush, Inc., 27 USPQ2d 1711 (TTAB 1993). The testimony and evidence clearly show this.

Opposer conceived of the idea for his radio show and decided on "TALKING PICTURES" as the name for it in 1995. The mark was used in several presentations to prospective customers, radio stations, in 1996 and 1997, and on June 13, 1997, the first live radio show presented under the mark "TALKING PICTURES" was aired on radio station WGCH in Greenwich, Connecticut. The program initially ran for a half hour each Friday, and later expanded to a full hour on Saturdays. Movies and the movie industry are the subjects discussed in each show. Live discussions with listeners who call in are featured, along with interviews with people in the attainment field.

Opposer filed a use-based application to register his mark, but this was not until September 9, 1997, almost two

months after the opposed intent-to-the use application had been filed by Mr. Brown.

In view of opposer's priority of use, we turn to the question of whether confusion is likely. The predecessor of our primary reviewing court identified the principal factors to be considered in resolving this issue in the case of In re duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarities between the marks and the relationship between the goods or services.

Applicant has applied to register the same mark that opposer has previously used. The marks are identical in appearance, pronunciation and connotation. Their commercial impressions are indistinguishable.

Additionally, the services specified in the application are extremely similar to those with which opposer has used the mark. Applicant intends to use the mark to identify his entertainment services in the nature of interviews and seminars relating to the film industry. Opposer has used it in connection with his entertainment services in the nature of radio programming featuring interviews and discussions relating to the film industry. Plainly, the use of the same mark, featuring the same double entendre about motion pictures, would be likely to cause confusion. Applicant has

not provided the Board with any evidence, testimony or reason to conclude to the contrary.

Decision: The opposition is sustained and registration to applicant is refused.